REMARKS

In view of the amendments proposed above, Applicants respectfully request consideration of the following remarks.

Anticipation Rejections Under 35 U.S.C. § 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Anticipation Rejection Based on United States Patent 6,628,053 to Den et al.

Claims 1-5, 18-24, 36, and 37 were rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent 6,628,053 to Den et al. (hereinafter "Den"). Applicant respectfully traverses this rejection as set forth below.

Claims 1-5 and 18-24

Independent claim 1 was amended to include limitations similar to those recited in claim 6, which was canceled. The Examiner indicated that claim 6 contained allowable subject matter and, therefore, Applicant believes claim 1 is novel in view of the cited art. Also, claims 2-5 and 18-24 are allowable as depending from novel independent claim 1.

Claims 36 and 37

Applicant believes that Den fails to disclose at least some limitations of independent claim 36, as amended (e.g., "separating the porous material layer and carbon nanotubes from the sacrificial layer and the substrate to form a free-standing composite carbon nanotube structure"). Thus, Applicant believes claim 36 is novel in view of Den and, further, that claim 37 is allowable as depending from novel independent claim 36.

Anticipation Rejection Based on United States Patent 6,741,019 to Filas et al.

Claim 36 was rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent 6,741,019 to Filas et al. (hereinafter "Filas"). Applicant respectfully traverses this rejection as set forth below.

Filas discloses the formation of a matrix layer 24 including a number of coated carbon nanotubes 15; however, the matrix layer 24 is not described as porous nor are the carbon nanotubes formed in pores of the matrix layer (the matrix layer is essentially formed around the carbon nanotubes). See, e.g., FIGS. 1D-1F of Filas and the accompanying text at Column 9, Line 27 thru Column 10, Line 51. Thus, Filas fails to disclose at least the limitation of "forming carbon nanotubes in pores of the layer of porous material", as recited in claim 36. Accordingly, claim 36 is novel in view of Filas.

Obviousness Rejections Under 35 U.S.C. § 103

To reject a claim or claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a prima facie case of obviousness. M.P.E.P. § 2142. When

establishing a prima facie case of obviousness, the Examiner must set forth evidence showing that the following three criteria are satisfied:

> First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. M.P.E.P. § 2142 (citing *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). Also, the evidentiary showing of a motivation or suggestion to combine prior art references "must be clear and particular." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Obviousness Rejection Based on United States Patent 6,741,019 to Filas et al.

Claim 38 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Filas. Applicant respectfully traverses this rejection as set forth below.

As noted above, Filas fails to disclose all limitations of independent claim 36 and, therefore, claim 36 is nonobvious in view of Filas. If an independent claim is nonobvious, then any claim depending from the independent claim is also nonobvious. M.P.E.P. §2143.03 (citing *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)). Therefore, claim 38 is allowable as depending from nonobvious independent claim 36.

CONCLUSION

Applicant submits that claims 1-5, 7-24, and 36-38 are in condition for allowance and respectfully requests allowance of such claims.

Please charge any shortages and credit any overages to Deposit Account No. 02-2666.

Respectfully submitted,

Date: September 23, 2005

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313 on:

September 21, 2005

Katherine Cummings
Name of Person Mailing Correspondence

Signature

9-21-05
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